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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,332	08/20/2001	Gregory P. Fitzpatrick	BOC9-2001-0007 (242)	5985

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EXAMINER

BILGRAMI, ASGHAR H

ART UNIT PAPER NUMBER

2143

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/933,332

Applicant(s)

FITZPATRICK ET AL.

Examiner

Asghar Bilgrami

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-30,36 and 39-64 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-30,36 and 39-64 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/18/2006 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1,4-15, 17, 18, 20-22, 24, 26, 27, 36, 39-47, 52, 55-57, 59-64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gudjonsson et al (U.S. 6,564,261 B1) and Tornabene et al (U.S. 2002/0023132 A1)

4. As per claims 1, 13-15, 18 & 36 Gudjonsson disclosed a method for sharing contact list information between participants of a chat session, comprising: identifying a first contact list containing contact information relating to contacts of said first chat session participant and

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identifying a second chat participant having a second contact list containing contact information relating to contacts of the second chat participant, said first chat session participant and said second session participant participating within a common chat session; providing the second chat participant with access to contact information contained within the first contact list (col.24, lines 32-43, col.25, lines 6-20, col.27, lines 36-44, col.29, lines 64-67 & col.30, lines 1-30). However Gudjonsson did not explicitly disclose determining whether said first contact list is modifiable by said second chat session participant and modifying said first contact list by said second chat session participant if said first contact list is modifiable by said second chat session participant, wherein modifying comprises the step of adding contact information to said first contact list the contact information pertaining to parties other than the first and second chat session participants; and providing the first session participant with access to information contained within said second contact list. In the same field of endeavor Tornabene disclosed determining whether said first contact list is modifiable by said second chat session participant and modifying said first contact list by said second chat session participant if said first contact list is modifiable by said second chat session participant, wherein modifying comprises the step of adding contact information to said first contact list the contact information pertaining to parties other than the first and second chat session participants; and providing the first session participant with access to information contained within said second contact list (paragraphs. 6-8 & 77).

At the time the invention was made it would have been obvious to one in the ordinary skill in the art to have incorporated the capability of first participant to modify the contact list of the second participant as disclosed by Tornabene in a method of sharing contact list information as disclosed

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by Gudjonsson in order to achieve greater flexibility in information sharing among chat participants resulting in more interacting and enhanced chat session experience.

5. As per claims 17, 20, 52, 55 & 60 Gudjonsson-Tornabene disclosed 17 the method according to claim 16, further comprising the steps of: determining if said first contact list is modifiable by said second participant to the communication session; and if said first contact list is modifiable by said second participant, adding selected dissimilar contact records to said first contact list. (Tornabene, paragraphs. 6-8 & 77).

6. As per claims 4, 5, 6, 7, 21, 22, 39, 40, 41, 42, 56, 57, 63 & 64 Gudjonsson-Tornabene disclosed the GUI according to claim 40, further comprising the step of displaying an icon within a chat session interface used by the first chat session participant to indicate whether said second contact list is accessible to said first session participant (Gudjonsson col.25, lines 6-20 col.26, lines 59-67 & col.27, lines 1-4 col.30, lines 1-16 & col.26, lines 40-58).

7. As per claims 8 & 43 Gudjonsson-Tornabene disclosed the method according to claim 1, further comprising the steps of: identifying a third chat session participant maintaining a third contact list containing contact information relating to contacts of said third chat session participant, said third chat session participant participating within said common chat session; and providing the third session participant with access to the contact information contained within the first contact list and the second contact list and providing the first chat session participant and said second session participant with access to contact information contained within the third

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contact list (Gudjonsson col.4, lines 31-33, col.29, lines 64-67, col.30, lines 1-16 & col.26, lines 40-58).

8. As per claims 9 & 44 Gudjonsson-Tornabene disclosed the method according to claim 8, further comprising the steps of: permitting the selection of said displayed icon for said first contact list and said displayed icon for said second contact list by a third chat session participant having a third contact list; comparing said selected first contact list and said selected second contact list to said third contact list (col.30, lines 1-16 & col.26, lines 40-58); and displaying to said third chat session participant contacts that are common to said first selected contact list, said second selected contact list, and said third contact list according to results from said comparing step (Gudjonsson col.30, lines 15-29).

9. As per claims 10, 24, 26, 27, 45, 59 & 61, 62 Gudjonsson-Tornabene disclosed the method according to claim 9, further comprising the steps of: permitting any of said first chat session participant, said second chat session participant and said third chat session participant to modify any of said first contact list, said second contact list and said third contact list (col.27, lines 36-44) according to results from said comparing step col.26, lines 37-58); and permitting any of said chat session participants associated with said contact list to reject said modification (Gudjonsson col.25, lines 6-20).

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10. As per claims 11, 12, 47 & 46 Gudjonsson-Tornabene disclosed the method according to claim 7, wherein if said display icon indicates that said first contact list is not modifiable, further comprising the step of requesting said first chat session participant to allow said second chat session participant to modify said contact list (Gudjonsson col.25, lines 21-42).

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 16, 19, 23, 25, 29, 28, 30, 48-51, 53, 54 & 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Gudjonsson.

13. As per claims 16, 19, 23, 25, 28, 29, 30, 48-51, 53, 54 & 58 Gudjonsson disclosed a method for providing contact management to parties engaged in a chat communication session, the method comprising: identifying a first contact list containing contact information relating to contacts of said first chat session participant and identifying a second chat participant having a second contact list containing contact information relating to contacts of the second chat participant, said first chat session participant and said second session participant participating within a common chat session; providing access for said first contact list to a second participant to the communication session (col.26, lines 30-50); comparing said first contact list and second

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contact list; identifying similar contacts between contact records located in said first contact list and contact records located in said second contact list; presenting similar contacts in a pre-selected visual format and dissimilar contacts in a different visual format; and adding selected dissimilar contact records located in said first contact list to said second contact list (col.29, lines 64-67 & col.30, lines 1-30).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Asghar Bilgrami whose telephone number is 571-272-3907. The examiner can normally be reached on M-F, 8:00-5:00PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



AB

Asghar Bilgrami
Examiner
Art Unit 2143



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